REMARKS

General Remarks

Claims 1-14 are all the claims currently pending in the present application.

Objections. Claim 8 stands objected to under 37 C.F.R. § 1.75.

With this Amendment, Applicant amends Claim 8, as shown, for purposes of clarity and

to explicitly recite within the claim what was believed to have already been implicitly defined

therein. Accordingly, these amendments do not foreclose application of reasonable equivalents.

Therefore, in view of the above, Applicant respectfully requests that the Examiner's

objection to Claim 8 be reconsidered and withdrawn.

Allowable Subject Matter. The Examiner indicates that Claims 5-7 and 14 contain

allowable subject matter and would be allowed if rewritten into independent form including the

limitations of the claims from which they depend. Applicants respectfully request that the

rewriting of these claims be held in abeyance until the Examiner has considered the argument

presented herein with respect to Claim 1.

Claims 1-3, 8, 9, 11, and 12 over Zigmond

Claims 1-3, 8, 9, 11, and 12 stand rejected under 35 U.S.C. § 102(e) as allegedly

anticipated by Zigmond et al., U.S. Patent No. 6,698,020 ("Zigmond"). Of these claims, Claims

1, 9, 11, and 12 are independent claims.

Regarding Claims 1, 9, 11, and 12, Applicant submits that Zigmond fails to disclose or

suggest at least assigning an evaluation value to received, stored advertisement data, as claimed,

based on a reproduction time, a reproduction position, and a preference of a user, as claimed and

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also fails to disclose or suggest presenting extracted advertisement data to a user in order of

highest evaluation value, as claimed.

Zigmond describes a system for inserting advertisements into a video programming feed

including an ad insertion device 80. (Abstract; Figs. 3 and 5). According to Zigmond, an ad

delivery source delivers ads to the ad insertion device 80. The ads may be directly stored in an

advertisement repository 86 or may be "pre-screened" by an ad filter 84, which uses selection

criteria 83 to select ads which are stored in the advertisement repository 86 and those which are

discarded. (Col. 15, lns. 17-23).

This filtering process fails to disclose or suggest assigning an evaluation value to stored

advertisement data. Rather this filtering process is similar to the process in the present invention

of setting selection standards and selecting and storing advertisement data which meet those

standards, which is required by Claims 1, 9, 11, and 12 in addition to the separate step of

assigning an evaluation value to stored advertisement data. Applicants note that the

advertisements which are subjected to the filtering process are not stored advertisements.

Applicants also note that there is no disclosure or suggestion that any evaluation value, which

determines the order of presentation of the advertisement data, as claimed, is assigned to any

advertisements in the filtering process.

Zigmond also describes that in step 110 of Fig. 6, "a stored advertisement is selected

according to the selection criteria." (Col. 17, lns. 24-25). This description indicates that of those

advertisements stored in the advertisement repository of Zigmond, on advertisement is selected

for presentation to a viewer according to the selection criteria. However, again, there is no

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disclosure or suggestion that any evaluation value, which determines the order of presentation of

the advertisement data, as claimed, is assigned to any advertisements in this selection step.

Applicants note that the Examiner appears to assert that such an assignment of an

evaluation value is inherent to the disclosure of Zigmond. (The Examiner notes that "The filtered

advertisements within the repository as inherently 'assigned an evaluation value' wherein the

filtered advertisements meets the 'selection standards' of what the viewer wishes to receive."

Office Action, p.3). Regarding this assertion, Applicants submit that the disclosure of Zigmond

does not *necessarily* require the assignment of an evaluation value which determines the order of

presentation of the advertisement data, as claimed.[1] Rather, Zigmond merely discloses that

certain criteria are used to select an advertisement for presentation. Accordingly, if a viewer

wishes to only view advertisements related to automobile manufacturers, for example, the

criteria could require that only an advertisement for an automobile manufacturer be selected for

display. This neither teaches nor necessitates the assignment of an evaluation value, as claimed.[2]

Therefore, in view of at least the above, Applicants submit that Zigmond fails to

anticipate the present invention as recited in Claims 1, 9, 11, and 12, and that Claims 2, 3, and 8

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[1] Evidence of inherency in a reference "must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

[2] "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *Id. (citing In re Oelrich*, 666 F.2d 578, 581 (Fed. Cir. 1981) (*quoting Hansgirg v. Kemmer*, 102 F.2d 212,214 (C.C.P.A. 1939)(*emphasis in original*)).

are patentable at least by virtue of their dependency. Applicants respectfully request that the

rejection of these claims be reconsidered and withdrawn.

Claim 4 over Zigmond and Hendricks and Claim 10 over Zigmond and Rakavy

Claim 4 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over

Zigmond, in view of Hendricks et al., U.S. Patent No. 6,408,437 ("Hendricks"). Claim 10 stands

rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Zigmond, in view of Rakavy et

al., U.S. Patent No. 6,317,789 ("Rakavy").

Regarding Claims 4 and 10, Applicants submit that like Zigmond, discussed above,

Hendricks and Rakavy both fail to teach or suggest at least assigning an evaluation value to

received, stored advertisement data, as claimed, based on a reproduction time, a reproduction

position, and a preference of a user, as claimed and also fails to disclose or suggest presenting

extracted advertisement data to a user in order of highest evaluation value, as claimed.

Therefore, Claims 4 and 10 are patentable at least by virtue of their dependence on Claim

1, and Applicants respectfully request that the rejection of Claims 4 and 10 be reconsidered and

withdrawn.

Claim 13 over Zigmond and Seth-Smith

Claim 13 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over

Zigmond, in view of Seth-Smith et al., U.S. Patent No. 4,866,770 ("Seth-Smith").

Regarding Claim 13, Applicants submit that, like Zigmond, discussed above, Seth-Smith

fails to teach or suggest at least assigning an evaluation value to received, stored advertisement

data, as claimed, based on a reproduction time, a reproduction position, and a preference of a

user, as claimed and also fails to disclose or suggest presenting extracted advertisement data to a user in order of highest evaluation value, as claimed. Therefore, Claim 13 is patentable at least by virtue of its dependence on Claim 9.

Further, Applicants respectfully submit that a combination of Zigmond and Seth-Smith fails to teach or suggest at least a plurality of advertisement sections, each comprising the same plurality of sponsor advertisements, such that each sponsor advertisement is repeated in each of the plurality of advertisement sections, as claimed.

The Examiner acknowledges that Zigmond fails to teach the above-recited limitation, and therefore relies on Seth-Smith. (Office Action, p. 7). The Examiner asserts that it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the 'advertisement sections' disclosed by Zigmond to be repeated, as taught by Seth-Smith." (Office Action, p. 7).

Applicants note that the "packets" A, B, and C, illustrated in Fig. 8 and described at col. 15, lns. 1-20 of Seth-Smith are each repeated five times *consecutively* and then the subsequent packet is repeated fives times *consecutively*, and so on. For example, packet A is transmitted five times and then packet B is transmitted five times, and then packet C is transmitted five times (i.e. AAAAA, BBBBB, CCCCC). In contrast, claim 13 recites that each advertisement section comprises the same plurality of sponsor advertisements (e.g. sponsor advertisements W, X, Y, and Z), such that each sponsor advertisement (e.g. sponsor advertisement W) is repeated in each plurality of advertisement sections, where an advertisement section includes, for example, sponsors W, X, Y, and Z. In other words, each advertisement section (e.g. a grouping of four

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advertisements), includes the same plurality of sponsor advertisements (e.g. each grouping includes ads from sponsors W, X, Y, and Z), such that each sponsor advertisement (e.g. sponsor advertisement W) appears in each advertisement section. Thus, a string of advertisement sections could be: "WXYZ," "XWYZ," "WYXZ," "YXWZ," "XZYW," etc, such that each sponsor advertisement is repeated in each advertisement section, but not necessarily in the same order. In contrast, the teaching of Seth-Smith would suggest that each advertisement be repeated five times in a row before proceeding to the transmission of a second advertisement, also five times in a row, such as: "WWWWW," "XXXXX." "YYYYY," "ZZZZZ," etc.

Therefore, even assuming, *arguendo*, that one of skill in the art would be motivated by Seth-Smith to use majority logic for error elimination, as suggested by the Examiner, all of the limitations of Claim 13 would not be met by a combination of Zigmond and Seth-Smith.

In view of the above, Applicant submits that Claim 13 is patentable over Zigmond and Seth-Smith and respectfully requests that the Examiner's rejection thereof be reconsidered and withdrawn.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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